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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/645,457	01/24/91	KYLE	D 1496-124A

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EXAMINER
JORDAN, K

ART UNIT 125

PAPER NUMBER 2

DATE MAILED 05/13/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-66 are pending in the application.
   Of the above, claims 1-28 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 29-66 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 those drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

#2

Claims 29-66 are presented for examination.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-28, drawn to a process of making an infant formula supplement, classified in Class 426, subclass 601+.

II. Claims 29-66, drawn to blended oil compositions, classified in Class 514, subclass 560.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the process as claimed can be practiced with another materially different product such as Italian salad dressing.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification restriction for examination purposes as indicated is proper.

During a telephone conversation with Barbara Ernst on April 24, 1991 a provisional election was made with traverse to

prosecute the invention of Group II, claims 29-66. Affirmation of this election must be made by applicant in responding to this Office action. Claims 1-28 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide sufficient exemplary matter to support claims as broad as claim 29 wherein the amounts or ratios between the components are not recited.

Claims 29, 30, 33, 34, 36-41, 43-46, 49, 52-56, 58-66 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The above claims fail to recite any amounts or ratios for the components of the composition.

Claims 29, 30, 33, 34, 36-41, 43-46, 49, 52-56, 58-66 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

Specifically, the claims are rendered indefinite by failure to recite any amounts or ratio for the components of the claimed composition so as to define the metes and bounds of what applicant considers to be his invention.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 29-35, 43, 45-51, 58-64 are rejected under 35 U.S.C. § 103 as being unpatentable over Ensor et al. (A). The claims appear to be drawn to compositions comprising at least two long-chain polyunsaturated fatty acid oils in general and more specifically oils that contain arachidonic acid, docosahexaenoic acid, eicosapentaneoic acid, and fish oil. Ensor et al. disclose feed compositions comprising various oils such as marine, animal, plant, and vegetable oils containing fatty acids such as

arachidonic acid, eicosapentenoic acid and docosahexaenoic acid (column 2, lines 22-46). The claimed subject matter differs from the disclosure of the primary reference in claiming specific ratios of fatty acids and specific oils sources. The determination of the optimum amounts and/or proportions of ingredients to employ is considered to be, absent evidence to the contrary, well within the skill of the art as such optimization is the goal of any such composition. The choice of specific oils is deemed to be a matter of obvious alternative, absent evidence to the contrary, since the fatty acids contained therein are chemically the same. The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references.

Claims 29, 36-44, 54-62, 65, 66 are rejected under 35 U.S.C. § 103 as being unpatentable over Cotter et al (K). The claims appear to be drawn to compositions comprising at least gamma linolenic acid containing oil and an oil containing docosahexaenoic acid, as well as other types of oils. Cotter et al. disclose nutritional compositions comprising marine oils and gamma linolenic acid. The marine oils include eicosapentenoic acid and docosahexaenoic acid. (Note the abstract and column 6, lines 15-25). The claimed subject matter differs from the disclosure of the primary reference in claiming specific ratios of fatty acids and specific ratios of fatty acids and specific

oils sources. The determination of the optimum amounts and/or proportions of ingredients to employ is considered to be, absent evidence to the contrary, well within the skill of the art as such optimization is the goal of any such composition. The choice of specific oils is deemed to be a matter of obvious alternative, absent evidence to the contrary, since the fatty acids contained therein are chemically the same. The claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references.

The remaining references listed on the enclosed PTO-892 are cited to further show the state of the art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Jordan whose telephone number is (703) 308-3728.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Between the 5th of June and the 12th of June 1991, Examining Group 120 will be moving from Crystal Plaza Building 2 to Crystal Mall Building 1. During and after this transition period the

Examiner can be reached through the Group 120 receptionist (703) 308-1235 which number will remain unchanged after the move. Subsequent to the move the examiner can be reached at (703) 308-4611.

FREDERICK E. WADDELL
EXAMINER
GROUP ART UNIT 125

Jordan:st
May 08, 1991